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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

TRINH, MINH N

ART UNIT PAPER NUMBER

3729

DATE MAILED: 02/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/545,288

Applicant(s)

AYALA ET AL.

Examiner

Minh Trinh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) 3,5-12 and 25-30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4 and 13-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 7/20/2000.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Applicant's traverse of the requirement for election of species is noted, asserting that there is no serious burden on the examiner to examine all claims. The traverse has been carefully considered, but is not persuasive because the reasons proffered do not appear germane to the propriety of a requirement for election of species. The sections of the manual cited relate to restriction, not a requirement for election of species, which is clearly covered in section 808.01(a). Once the claims are determined to be directed to mutually patentable inventions and the Office requires an election of species, a persuasive traverse is an admission on the record that applicant does not find the claimed species are patentable, one over the other. Having not done so, the reasons presented are not persuasive. Applicant is not entitled to examination of multiple independent inventions in one application. Moreover, examination of the independent inventions herein would clearly present a burden because the searches will not be coextensive. Accordingly, the requirement is repeated and **made final**.

2. Claims 3, 5-12 and 25-30 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species inventions (species 1B, 2B, 3B, and 4A, 4B, 4C), there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 10/25/04.

Further, it is agreed that claims 1, 2 and 4-30 are read on elected species 1A. However, it is disagreed about the election of species 2A, 3A and 4D because these species should have been based on the elected claims 1, 2, 4-29 and 30 of species 1A

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instead of claims 1-30, as a result, it is noted that only claims 1, 2, 4, 13-24 are readable on the elected species 1A, 2A, 3A and 4D.

An Office action on the merits of elected claims 1, 2, 4, 13-24 as follows.

Claim Objections

3. "Manufacturing method" (dependent claims 2, 4, 13-24, line 1) should be rewritten to: --The method of manufacturing --, as to reflect the dependent claim formats. Appropriate correction is required.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1, 2, 4, and 13-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The following are examples:

It is unclear as to what being claimed as "the said smart card"(claim 1, line 1). Also "the or said smart card" lacks proper antecedent basis because the preamble is directed to plural of smart cards but not in format of single smart card.

It is unclear whether "a connection pad" (claim 1, line 7) is one of "connection pads" of line 2 of claim 1.

Further, the claim does not clearly recite the method manufacturing steps the following steps such as "winding, forming insulation bridge, forming contact pads, and

connecting the antenna to the pads" are suggested. Also it is noted that provided, , located, as so to connect. . .and others as recited in claim 1, and " is produced "(claim 2, line 2), "wherein the modules comprises" (claim 13, line 2), etc are not positive method limitations.

The scope of claim 13 is not clear because the claims directed to a method of making smart card instead of the module assembly, the limitation recites "wherein the module comprises" (claim 13, line 2) which made scope of claim 13 unclear. Also, what is being referred as "intended to serve"(claim 13, line 5), "intended to be connected"(claim 13, line 6) is unclear and confusing because these limitations are not positive method limitations.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1, 2 and 14 as best understood are rejected under 35 U.S.C. 102(b) as being anticipated by Fidalgo (5,598,032).

Fidalgo discloses a method for manufacturing chip card or (smart card) having antenna the ends of which are provided with connection pads for connection to an electronic module comprising at least one stage consisting in producing the antenna having at least two turns 5 on a support sheet 3, said antenna having its turns located

outside the connection pads 11 and an insulating bridge 20 so as to connect each of the ends of the antenna to at least one of connection pads respectively. It is noted that reference 20 of related embodiment fig. 9 depicts an insulation bridge as broadly claimed by the present invention.

As applied to claim 2, Noting each of related Fidago's Figs. 1, 5 and 7 depicts the insulation being covering antenna 5 turns in zone Z direction.

As applied to claim 14, Fidago discloses the method recited in claim 14 including connection pads and the module, it is inherent to use low melting solder for connection module to the antenna (refer col. 6, lines 1-5).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 4, 13, 15-23 and 24 as best understood are rejected under 35 U.S.C. 103(a) as being unpatentable over Fidago in view of WO 97/34247 or France patent 2523335 hereinafter (FR 2,523,335).

As applied to claims 4, 13 and 24, Fidago is silent about assembling the support to a number of plastic foils to form a card body and machining a cavity and connection recesses in an upper face of the card body. The WO 97/34247 discloses the above (see Abstract and the Fig. associated therefrom). Further, the FR 2,523,335 discloses

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similar method as discussed above such as by assembling the support to a number of plastic foils to form a card body and machining a cavity and connection recesses in an upper face of the card body (see Fig. 2). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ the teachings of WO 97/34247 or FR 2523335 onto the method invention of Fidago in order to facilitate the fabrication process as so to form a desired card structural.

Limitations of claims 13 and 24 are also met by the above discussion (noting each of the secondary reference shows the intended use configuration limitations set forth in the claim 13, i.e., a microchip and double sided PCB, etc).

As applied to claims 15-20, it would have been obvious to one having skill in the art to incorporate use of particular materials as recited in these claims since it was known in the art that selecting a material from a host of group of available materials on the basis of its suitability for the intended use as a matter of obvious design choice.

Limitations of claims 16-20 are similar to that as discussed above.

As applied to claims 21-23, it would have been an obvious matter of design choice to choose any desired means for connection between the connection pads of the antenna and the conductive pads of the module including the use of grease charged, silicon gasket charged, and/or additional gold deposited by thermal compression since applicant has not disclosed that these features are critical, patentably distinguishing features and it appears that the invention would perform equally well with the conventional bonding techniques as taught by each of the prior art reference (i.e., see the discussion of Fidago at cols.5-6).


Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Prior art references are cited for their teaching of method of manufacturing chip card or smart card devices.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Minh Trinh whose telephone number is (571) 272-4569. The examiner can normally be reached on Monday -Thursday 8:00 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on (571) 272-4690. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

mt

Minh Trinh 1/18/05
Primary Examiner Group 3700